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		Examiner Name	Vishnu Mendiratta
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ENCLOSURES (Check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Date	February 13, 2007	Reg. No.	46,837

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

In re Application: Thomas Seth Belcher et al.

Group Art Unit: 3711

Serial No.: 10/627,440

Filed: 07/25/2003

Examiner: Vishnu Mendiratta

Title: *A Portable, Adaptable Drawing Surface for Strategy Games*

APPELLANT'S REPLY UNDER 37 C.F.R. 1.193

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Commissioner for Patents
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Dear Sir:

Appellant hereby submits its Reply Brief under 37 C.F.R. § 1.193 in support of its appeal.

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George P. Kobler, Registration No. 46,837

Remarks

Examiner suggests that whether an article is proposed to be drawn upon would be the intended use of an apparatus, and would not further the apparatus in the claims. This is true if Applicant proposed such a use as a limitation in its claims without a corresponding structural element. However, in this context the proposed use of an article was submitted to indicate the reasoning behind the design and structural elements of an article disclosed in a prior patent reference. Specifically, if the game board taught by allegedly anticipating reference *Bassett* were intended to be drawn upon with a dry-erase marker, it would have disclosed an appropriate structural element to accommodate that use. Applicant still maintains that it does not. Examiner's Answer still asserts no fact or legal support for the mysterious conclusion that *Bassett* expressly or inherently discloses the structures set forth in the claims of the present application. As such, Examiner erred in maintaining the rejection under Sec. 102 based upon *Bassett*.

Dry-erase markers are designed to be used on non-porous surfaces. The U.S. patents cited by Examiner in his answer support this. For example, U.S. Pat. No. 6,402,144 discloses “[i]t is understood that both sides of each card may include a coating suitable for use with dry erase markers such that other sets of indicia may be manipulated as desired by a user, for example, musical notes.” Col.5, 62- 65. And U.S. Pat. No. 5,741,561 teaches that for its invention, “[a]t least the top sheet of

placemat 10 comprises a clear vinyl and preferably has a silicone coating which is double polished to allow easy wiping off of markers made with a dry erase marker. It should be appreciated that other conventional techniques or materials which allow the wiping of dry erase markers can be used.” Col.2, ll 32-37. The surface upon which it is intended that dry-erase markers are to be used must be specifically treated in order so that marks made with such markers may be easily erased. This is a structural element of the present claims that is not taught in any way by *Bassett*. Examiner’s response provides no evidence that all plastic materials are compatible with the use of dry-erase markers which is necessary in order to support a rejection under 35 U.S.C. Sec. 102.

Examiner’s response also fails to provide the required motivation for combining *Bassett* and the secondary reference, *Ward* (U.S. Pat. No. 4,060,246). In addressing motivation to combine, Examiner simply lists desirable features of plastic in general, and asserts that often players write notes or rules on game boards. However, to successfully show motivation to combine references in support of a rejection under either 35 U.S.C. Section 103, the Examiner must provide evidence; Examiner’s conclusory statements are insufficient. See *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). Examiner further asserts that “it remains a fact that (sic) Bassett board is ‘substantially non-porous’, and could be used with dry-erase marker.” Applicant concedes that dry-erase markers may be used to mark on a plastic board, or

cardboard, or tissue, or human skin for that matter. However, nowhere does *Bassett* disclose that marks made by dry-erase markers on a plastic board are easily erasable. Therefore, whether the board disclosed in *Bassett* is suitable for use with dry-erase markers such that marks made by said markers are easily erasable is not a fact. Examiner's arguments still fail to provide the requisite motivation. Because the Examiner has not provided the motivation to combine the references, there is no *prima facie* case of obvious and the rejection under Sec. 103 should be withdrawn.

The § 103 rejection of claims 1 and 11 based on *Bassett* and *Ward* is in error. As an initial matter, Examiner fails to identify a legally cognizable suggestion for combining *Bassett* and *Ward*. In this regard, the Examiner states: “One of ordinary skill in the art at the time the invention was made would have suggested using plastic material that are (sic) substantially non-porous and compatible to dry-erase markers by using the same board [of *Bassett*] over and over again for the purpose of [saving] money (sic).” However, as a matter of law and fact, this is not a proper suggestion for combining *Bassett* and *Ward*.

Turning first to the legal error, Applicants wishes to remind the Office of the bedrock legal principles for rejecting a claim under 35 U.S.C. § 103. Specifically, in *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) the Federal Circuit explained:

To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.

Id. at 1455 (citations omitted and emphasis added).

In *Rouffet*, the Examiner had rejected the pending claims on a combination of references. The Board sustained the Examiner. However, the Federal Circuit reversed the Board's decision and ruled that the Examiner's rejections were legally impermissible because they failed to demonstrate a suggestion for combining the references in the manner proposed by the Examiner. As explained by the Federal Circuit:

As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.

Id. at 1457-58 (citations omitted and emphasis added). These principles have not been followed in rejecting claims 1 and 11. Merely stating an advantage or possible advantage of combining references, as was done to reject Claims 1 and 11, is not the same as “show[ing] a motivation to combine the references.”

On the contrary, in order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a *prima facie* case of unpatentability, particular factual findings demonstrating the suggestion to combine must be made. See, for example, *Ecolochem Inc. v. Southern California Edison*, 56 U.S.P.Q.2d 1065, 1072-73 (Fed. Cir. 2000) and *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999). Indeed, the law is quite clear that an obviousness rejection must be based on facts, not conjecture.

The Supreme Court... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness *must be supported by facts*. Where the legal conclusion is not supported by facts it cannot stand.

In re Warner, 379 F.2d 1011, 1017 (C.C.P.A. 1967). This longstanding principle has been followed to date. For example, in the unpublished Board decision, *Ex parte Megens*, App. No. 1999-0277 (B.P.A.I. Oct. 29, 1999), the Board stated:

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

The examiner's conclusion that it would have been obvious to incline Phillips' loading dock floor 65 rests on the completely unfounded assumption that it would be desirable to drain liquid from the floor. The Phillips reference, however, is devoid of any indication that liquid might accumulate on the floor or that such accumulation would pose a problem even if it did occur. It is therefore apparent that the examiner has resorted to improper speculation and hindsight reconstruction to overcome the admitted deficiency of Phillips vis-à-vis the subject matter recited in claim 1.

(Megens at Pages 4-5)(emphasis added).

This is precisely the situation presented here. The “suggestion” in support of the rejection of claims 1 and 11 amounts to nothing more than a speculative statement that, given the alleged presence of the claim elements in the prior art and an advantage that combining these elements would allegedly achieve, a person skilled in the art would have found it obvious to combine the references to create the claimed invention. The problem with this approach is that it effectively eliminates the requirement of identifying a suggestion for combining references from

the obviousness analysis. More specifically, the Office's analysis proceeds in the following manner:

- a) What elements are present in the pending claims?
- b) Can these elements be found in prior art references?
- c) If they can be found, and the references themselves provide no suggestion for combining these elements, can some end or advantage be identified to combine the elements in the manner proposed in the Applicants' claims?
- d) If so, combine the elements in the manner proposed by the Applicants and reject the pending claims.

This mode of analysis is, of course, deeply flawed. Specifically, as noted by the Federal Circuit in *Rouffet* quote identified above, all of the elements of most claimed inventions can almost always be found in the prior art. Therefore, the answer to step "b" above will almost always be "yes". Since it is a statutory requirement that all inventions have utility, there will also always be an identifiable end or advantage in combining the elements in the prior art in the manner proposed by any claim (e.g., if there was no purpose to an element in a claim it would not be included in the claimed apparatus, after all, who would pursue a claim with superfluous elements or a claim with no utility?). Therefore, if the "suggestion" requirement of 35 U.S.C. § 103 can be met by merely identifying any end or advantage which will be achieved by combining

the elements of the prior art references, the suggestion requirement can always be met
and is utterly meaningless.

This inherent flaw in the analysis employed in rejecting claims 1 and 11 is elucidated by viewing the alleged “suggestion” the Office action identifies in support of the rejection. In rejecting claims 1 and 11, the Examiner states: “In order to save money, it would have been obvious to use plastic material that are (sic) substantially non-porous and compatible to (sic) dry-erase markers [as taught by *Ward*] by using the same board [of *Bassett*] over and over again” and “One of ordinary skill in the art at the time the invention was made would have suggested using plastic material that are (sic) substantially non-porous and compatible to dry-erase markers by using the same board over and over again for the purpose of [saving](sic) money.” The first part of the statement, namely, “One of ordinary skill in the art at the time the invention was made would have suggested . . .” is merely boilerplate language that does not address the suggestion requirement. The second part of the statement, namely, “to use plastic material that are (sic) substantially non-porous and compatible to (sic) dry-erase markers [as taught by *Ward*] by using the same board [of *Bassett*]” simply states what the proposed modification of the primary reference is to be; in this case modifying *Bassett* to include a surface compatible with dry-erase markers. This second part of the statement, thus, describes the proposed modification, but offers no explanation of a motivation for making that modification. The final part of statement,

namely, “using the same board over and over again for the purpose of [saving] money” must be the alleged “motivation” for modifying *Bassett*.

However, while it is true that one possible advantage of a dry-erase surface is using the surface over and over again to save money, that is not a suggestion in and of itself for using a dry-erase surface in *Bassett*. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992)(emphasis added). Here, the Examiner does not identify any evidence in the prior art indicating or in any way suggesting the desirability of the proposed modification. It only identifies an old element that has an inherent property. Indeed, the Examiner’s naked, conclusory statement amounts to nothing more than stating “A person of ordinary skill in the art would be motivated to modify *Bassett* to include dry-erase surface because they would want to gain a benefit from having a dry-erase surface.” In other words, the Examiner is effectively saying that the motivation of adding a dry-erase surface to *Bassett* is to have the inherent benefit of adding dry-erase surface. Of course, such circular reasoning (i.e., add “X” to have “X”) cannot be a legally proper tool for identifying a suggestion for combining references. If it were, no combination of old elements would ever be patentable since one can always nakedly state, a person would be motivated to add old element X from one reference to another reference

because adding element X offers an advantage (again, if adding “X” had no advantage, who would ever claim it?). Simply put, there is *always* an advantage to combining old elements that can be identified through hindsight *once that combination is known*.

It should be quite clear from the above that merely identifying an advantage for adding an old element to a combination of elements is not a proper suggestion for making that combination. The MPEP further proves this point. In particular, MPEP § 2144 states that “the strongest rationale for combining references is a recognition... in the prior art or... based on established scientific principles or legal precedent, that some advantage would have been produced by their combination.” The MPEP cites *In re Sernaker*, 702 F.2d 989, 994-95 (Fed. Cir. 1983) to support this proposition.

Looking at the *Sernaker* case, we see that the Federal Circuit states: “The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.” *Sernaker*, 702 F.2d at 995-96 (emphasis added). Notice that this statement does not state that it is obvious to combine references simply because there is an advantage to doing so. On the contrary, it carefully states that there can be no obviousness ruling unless something in the art suggests an advantage to combining the references. The advantage itself is not the suggestion, but rather the Court makes it clear that something else suggests

the advantage.

The MPEP quote noted above is similar. It states that the “strongest rationale for combining references is a recognition... in the prior art or... based on established scientific principles or legal precedent that some advantage or expected beneficial result would have been produced by their combination.” (MPEP, Page 2100-127) (emphasis added). This, of course, does not state that the strongest rationale for combining references is the mere presence of an advantage to doing so. Instead, as in *Sernaker*, the strongest rationale is a recognition (i.e., a suggestion) in the art that an advantage will result.

Turning back to the rejections at issue, rather than identifying something in the art that suggests an advantage to making the combination, the Examiner just looks for the advantage itself and mislabels that advantage as “suggestion.” As explained above, this is a literal elimination¹ of the suggestion requirement. Since there is always an advantage to a claimed element (or why would you claim it?), the Examiner’s misplaced view of an advantage as the suggestion inherently renders all combinations of old elements unpatentable precisely because it eliminates the suggestion requirement from the analysis. Clearly, neither the MPEP section noted above nor the *Sernaker* case upon which that MPEP section rests for authority stands

¹It literally removes the “recognition” portion of the MPEP quote above and the “something in the art” portion of the *Sernaker* quote.

for the proposition that an advantage of an element is a suggestion in and of itself for including that element in a combination.

In view of the foregoing, applicants respectfully submit that the § 103 rejection of claims 1 and 11 must be withdrawn because it fails to identify a legally proper suggestion for combining the prior art references in the manner proposed by the Examiner. In other words, the Office has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. On this basis alone, the rejections of claims 1 and 11 and all claims depending therefrom must be withdrawn.

Finally, the first elements of Claims 1 and 11, as amended, require that each of the sides of the tiles comprising the present gameboard include means for interconnecting with like tiles. This element is likewise not disclosed in either *Bassett* or *Ward*. *Bassett* discloses tiles (or “segments”) that have sides without means for interconnecting. This is because the board of *Bassett* is simply designed to stay in the same shape throughout its use. Examiner’s arguments do not address this feature of Applicant’s invention. The two references argued by examiner do not disclose this element or suggest it. Therefore, Claims 1 and 11, and their respective dependent claims are neither anticipated under Sec. 102, nor are they rendered obvious under Sec. 103.

Based upon the foregoing, Applicant respectfully submits that all of the rejections should be withdrawn and earnestly requests that the Board remand the case

with instructions to allow the case as amended.

Respectfully submitted,



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